AF/2152

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

On Appeal to the Board of Appeals and Interferences

Applicant(s)	:	Hari Kalva et al.	Examiner:	Beatriz Prieto
Serial No.	:	09/240,509	Art Unit:	2152
Filed	:	January 29, 1999		
For	:	CONTROL MESSAGE TECHNIQUE FOR USER INTERACTION IN A TELECOMMUNICATIONS NETWORK		

REPLY BRIEF

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

December 20, 2004
Date of Deposit

Paul A. Ragusa	38,587
Attorney Name	Registration No.
Signature	December 20, 2004
	Date of Signature

BAKER BOTTS LLP

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 0

Complete if Known	
Application Number	09/240,509
Filing Date	Jan. 29, 1999
First Named Inventor	Hari Kalva, et al.
Examiner Name	P. Beatriz
Art Unit	2152
Attorney Docket No.	AP 31569 (070050.0957)

METHOD OF PAYMENT *(check all that apply)*

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☑ Deposit Account:

Deposit Account Number: 02-4377

Deposit Account Name: Baker Botts LLP

The Commissioner is authorized to: *(check all that apply)*

☐ Charge fee(s) indicated below ☐ Credit any overpayments

☑ Charge any additional fee required under 37CFR 1.16 and 1.17

☐ Charge fee(s) indicated below, **except for the filing fee** to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) ($) 0

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

		Extra Claims		Fee from below	Fee Paid
Total Claims	- 20 =	0	X		= 0
Independent Claims	- 3 =	0	X		= 0
Multiple Dependent					=

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($) 0

***or number previously paid, if greater; For Reissues, see above*

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for *ex parte* reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,300	2453	650	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	630	2503	315	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) ($) 0

SUBMITTED BY				(Complete *(if applicable)*	
Name (Print/Type)	Paul A. Ragusa	*Registration No. (Attorney/Agent)*	38,587	*Telephone*	212-408-2588
Signature				*Date*	12/20/04

FILE NO. AP31569 – 070050.0957

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

On Appeal to the Board of Appeals and Interferences

Appellant(s)	:	Hari Kalva et al.
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Filed	:	January 29, 1999
For	:	CONTROL MESSAGE TECHNIQUE FOR USER INTERACTION IN A TELECOMMUNICATIONS NETWORK

Examiner: Beatriz Prieto

Art Unit: 2152

REPLY BRIEF ON APPEAL

On June 30, 2004, Appellant filed an Appeal Brief in the above-identified patent application opposing the final rejection of claims 1-14 memorialized in the Final Official Action issued by the U.S. Patent and Trademark Office (the "PTO") on July 7, 2003. An Examiner Answer was mailed on October 21, 2004. In response thereto and in accordance with 37 C.F.R. § 41.41, Appellant submits this brief in support of the appeal of the final rejection of pending claims 1-14. For the reasons set forth below, in addition to the reasons set forth in Appellant's June 30, 2004 Appeal Brief, the final rejection of pending claims 1-14 should be reversed.

I. Appellant's Response to Section (10) - Grounds of Rejection

As discussed in more detail in Appellant's Appeal Brief, Appellant's invention, as recited in independent claim 1, is a method for communicating command information between a server and a client across a network in an interactive communication system which comprises, *inter alia*:

(a) generating a command message including a command, a command descriptor, and one of a server route for directly associating a node with the command descriptor and a command node for indirectly associating a node with the command descriptor; and

(b) transmitting the command message across a network upon occurrence of a triggering event.

As in the Final Office Action, the Examiner's positions set forth in the Examiner's Answer are based on the cited Woods and Coven references, which relate to the VRML specification and specifically to VRML 2.0. However, the VRML techniques described in the references are acknowledged in the present application, Background of the Invention, as defining the state of the art at the time the present application was filed. These cited VRML techniques fail to address the problems to which the claimed invention are directed.

For example, the importance of a back channel and client-server communications in MPEG-4 systems is highlighted in the present application. As set forth in the Background of the Invention, "[i]nteractivity is a prominent concern in the development of the MPEG-4 international standard. A back channel is specified for interactive message support. However, the syntax and semantics of the messages to be carried through that channel remain unspecified, and so does the mechanism that triggers the transmission of such messages." (Specification, p. 1, lns. 6-11.) Furthermore, as stated in the specification, "MPEG-4 essentially uses two modes of interactivity: local and remote. Local interactivity can be fully implemented using the native

event architecture of MPEG-4 BIFS (Binary Format for Scenes), which is based on the VRML 2.0 ROUTEs design." (Specification, p. 1, lns. 26-29 (emphasis added)).

As clearly stated throughout the specification and elucidated by the claims, one of the objects of the invention is to provide *remote* interactivity between, e.g., client and server. Indeed, as acknowledged in the Background of the Invention of the specification, the VRML technologies which are the subject of the prior art relied upon by the Examiner can provide *local* interactivity, but that is *not* the subject of the claimed invention. In other words, as further stated in the Background of the Invention, "[t]he fact that MPEG-4 Systems already contains local interactive support via the use of event source/sink routes that are part of the scene description (BIFS) makes it desirable to have a server interaction process that fully integrates with the local interactivity model." The described "server interaction process" is the subject of the claimed invention, and the "local interactivity model" is the subject of the cited prior art.

Accordingly, the VRML references, e.g. the Woods reference, which focuses on transmission of messages *locally* (i.e., on the same computer), necessarily fail to disclose or suggest at least "generating a command message including a command, a *command descriptor*, and one of a *server route* for directly associating a node with the command descriptor and a command node for indirectly associating a node with the command descriptor," and "transmitting the command message *across a network* upon occurrence of a triggering event."

These same arguments apply to all the claims of Group 1 (claims 1-7). For at least these additional reasons, Appellant respectfully requests that the Board reverse the Examiner's rejection of claims 1-7 under 35 U.S.C. § 103(a) as being taught or suggested by Woods in view of Cohen.

Additionally, these same arguments apply to distinguish the system claim 8 over the Woods and Cohen references, and the rejection of claim 8 as obvious is also improper. *See C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2D 1225, 1232 (Fed.Cir.1998). The same arguments also apply to all claims of Group 2 (claims 8-14). Accordingly, at least for the reasons presented above, Appellant respectfully requests that the Board reverse the Examiner's rejection of claims 8-14 under 35 U.S.C. § 103(a) as being taught or suggested by Woods in view of Cohen.

II. Appellant's Response to Section (11) - Response to Arguments

Appellant disagrees with several of the statements in the Examiner's Answer.

First, it is asserted on p. 6 of the Examiner's Answer that:

> "[i]n response to the above-mentioned argument, claims 1 and 8, have been carefully reviewed, however, it is not found where in these claims there is a recitation of; "*a command comprises information to be transmitted back to the server computer upon the occurrence of an associated event*". There is further in claim 1, no *recitation of "a route which targets a command descriptor*", as argued. Thereby, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim 1 and 8. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims."
> Examiner's Answer, p. 6. (emphasis in original).

Appellant disagrees with the Examiner's arguments in this respect. While it is true that limitations from the specification are not read into the claims, the Examiner agrees that the claims are to be interpreted *in light of the specification*. As is clear from the specification, including all of the portions cited in Part I of this Reply Brief, the present invention is directed to client-server communications. Further, as clear from the plain language of claim 1, a command message is transmitted "across a network" upon occurrence of a triggering event. Based on the

claim's plain language, further supported by a reading of the claim in light of the specification, it is clear that the command of the claim comprises information to be transmitted back to a server computer upon occurrence of an associated event. Woods fails to disclose or suggest at least this limitation.

> Furthermore, on p. 8 of the Examiner's Answer, it is noted that:
>
> "(i) with respect to the claim's preamble, there is no recitation of a computer, i.e., a client computer nor a server computer in the claim, given the broadest reasonable interpretation inlight (sic) of the specification (see MPEP 2111), the "server" and "client" elements of the claim language are not required to be computers, they as well may be interpreted as process entities, (ii) with respect to the claim's preamble intended use, i.e. a method for communication command information between a server and a client across a network in an interactive communication system, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art." Examiner's Answer, p. 8 (emphasis in original).

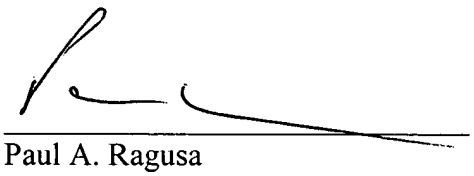
Appellant respectfully disagrees with the Examiner's statements in this respect as well. As would be understood by one of ordinary skill in the art reading the claim in light of the specification, claim 1 is directed to client-server communication, as in communication between computers on a network. This is clear from the portions of the specification cited in Part 1 of this Reply Brief (e.g., p. 1, lines 6-11, 26-29, etc.), as well as from the text of claim 1 itself (which recites, *inter* alia, "transmitting the command message across a network," clarifying that the claimed client and server are networked, separate computers). The Examiner's purported interpretation of the claim language is inconsistent with the stated objects of the invention and the plain language of the claim. Accordingly, for at least these additional reasons, Appellant respectfully requests that the Board reverse the Examiner's rejection of claims 1-7 under 35 U.S.C. § 103(a) as being taught or suggested by Woods in view of Cohen.

These same arguments apply to all the claims of Group 2 (claims 8-14). For at least these additional reasons, Appellant respectfully requests that the Board reverse the Examiner's rejection of claims 8-14 under 35 U.S.C. § 103(a) as being taught or suggested by Woods in view of Cohen.

III. Conclusion

For at least the reasons indicated above, in addition to all the reasons set forth in Appellant's Appeal Brief, Appellant respectfully submits that the invention recited in the claims of the present application, as discussed above, is new, non-obvious and useful. Reversal of the Examiner's rejections of the claims is therefore respectfully requested.

Respectfully submitted,

Dated: December 20, 2004 By: 

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